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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,323	06/02/2000	Robert Andrew Adamany	36968/185857	6460

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EXAMINER

NGUYEN, DUC M

ART UNIT PAPER NUMBER

2685

DATE MAILED: 07/01/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/586,323

Applicant(s)
Adamany et al

Examiner
Duc Nguyen

Art Unit
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 29, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

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DETAILED ACTION

This action is in response to applicant's response filed on 4/29/03. Claims 1-16 are now pending in the present application. **This action is made final.**

- Please also note for change in **Art Unit** number in future response.

Election/Restriction

1. Newly submitted and amended claims 11-16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the amended claim 11 recites a new limitation "locking the wireless unit prior to a registration of the wireless unit", which relates to a locking feature of the wireless unit, and which corresponds to another embodiment as disclosed on page 16, lines 2-9 of the specification. Because these inventions are distinct for the reasons given above and the search required for Group I (claims 1-10) is not required for Group II (claims 11-16), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

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2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable by **Amin et al** (EP Pub. Number **EP 0,788,287**).

Regarding claim 1, **Amin** discloses a roaming authorization system, wherein after successful registration, an authentication process is performed by the MSC-V for verifying identification information of the wireless device before providing originating communication service to the wireless unit (see col. 2, line 37 - col. 3, line 23 and col. 8, line 7 - col. 9, line 13), comprising :

- carry out a registration of the wireless unit in the visited system (roaming MSC-V) including validation of the wireless unit (MIN/ESN and roaming validation) with a home system (HLR) of the wireless unit (see col. 2, line 37 - col. 3, line 11);

- implementing, in response to the registration, a denial of originating communication service to the wireless unit (see registration denial, col. 3, lines 5-11). Here, although **Amin** differs from the claimed limitations in that the call set up is held and is delayed during the verification process rather than implement a denial and removing the denial service as claimed, it is noted that with the broadest reasonable interpretation and in light of the specification (i.e, see

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Fig. 2 of the specification), the holding state or delaying state in **Amin** could be interpreted as a denial state as claimed because both of them are used to achieve the same subject matter (prevent fraudulent use of a wireless roaming in a visited system by providing no service during the holding period) and the same solution (after the registration, denying originating service to the wireless unit until the wireless unit provides a positive identification information).

As to the newly-added claimed limitation of a verification element functionally connected to the MSC-V and the HLR, it is noted that since the verification process is performed between the MSC-V and HLR, it is clear that a verification element is **physically** located either at the MSC-V or the HLR and should be functionally connected to both the MSC-V and the HLR in order to perform the verification process. Therefore, the claimed limitations are made obvious by **Amin** for denying originating service to the wireless unit, after the registration, until the wireless unit has provided a positive identification information (see col. 3, lines 12-23).

Regarding claim 2, it is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Amin** implicitly discloses the step of updating and providing service as claimed (see col. 6, lines 18-47, col. 9, lines 26-33).

Regarding claim 5, it is rejected for the same reason as set forth in claim 1 above. In addition, **Amin** discloses the step of providing an announcement as claimed (see col. 3, lines 16-21).

Regarding claim 6, it is rejected for the same reason as set forth in claim 1 above. In addition, **Amin** discloses the step of dial the code and provide identification information as claimed (see col. 3, lines 19-21 and col. 8, line 51 - col. 9, line 13).

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4. Claims 3-4, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable by **Amin** in view of **Marchand et al** (PCT Pub. Number **WO 97/26769**).

Regarding claim 7, **Amin** discloses all the claimed limitations, see claim 1 above, except for the MSC to recognize the code as a feature request message comprising the identification information. However, in an analogous art, **Marchand** discloses a system for reducing fraud in a cellular communication system, wherein a feature request comprising identification information is used by a roaming user for fraud reduction (see col. 10, line 27 - col. 11, line 27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of **Marchand** to **Amin** to provide the code as a feature request message as claimed, for reducing fraud by changing service profiles according to the roaming area.

Regarding claims 3-4, they are rejected for the same reason as set forth in claim 7 above. In addition, **Amin** as modified would disclose the identification information comprises a PIN (see **Marchand**, col. 11, lines 1-27). Further, since using a centralized authentication center (read on an "international gateway" as claimed) for fraud prevention/detection is known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of **Marchand** and **Amin** to use an international gateway for performing the verification process as claimed, for fraud prevention or detection.

Regarding claims 8-9, they are rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Amin** implicitly discloses the step of updating and providing service as claimed (see col. 6, lines 18-47, col. 9, lines 26-33).

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Regarding claim 10, it is rejected for the same reason as set forth in claim 1 above. In addition, **Amin** discloses the step of dial the code and provide identification information as claimed (see col. 3, lines 19-21 and col. 8, line 51 - col. 9, line 13).

Response to Arguments

5. Applicant's arguments with respect to claims 1, 11 have been considered but are moot in view of the new ground(s) of rejection.

As to Applicant's argument that "Amin performs the registration denial after the call is already originated", Applicant is directed to page 3, lines 9-10 of Amin's reference, wherein the registration denial is initiated, which is clearly performed before call originating because a call can only be made and routed after it has registered successfully with the serving MSC.

As to Applicant's argument that "Amin fails to teach or suggest the steps of denying and removing the denial" and that in claim 1, "the denial is performed before the verification", it is noted with the **broadest reasonable interpretation**, the "holding state" or "delaying state" in **Amin** would read on the "denial state" as claimed because no service is provided during this holding period for verification, hence, the denial is clearly performed before the verification. Similarly, when the call is completed to its intended destination, it is clear that the denial has been removed.

For foregoing reasons, the examiner believes that the pending claims are not allowable over the cited prior art

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-

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Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is (703) 308-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

June 25, 2003

A handwritten signature in black ink, appearing to read "Duc M. Nguyen", written over the typed name and date.